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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,662	04/09/2004	Jeff Blaney	022132-001110US	8787

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EXAMINER

LUNDGREN, JEFFREY S

ART UNIT PAPER NUMBER

1639

DATE MAILED: 10/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/821,662	<b>Applicant(s)</b> BLANEY ET AL.	
	<b>Examiner</b> Jeff Lundgren	<b>Art Unit</b> 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 5, 50 and 57-69 is/are pending in the application.
- 4a) Of the above claim(s) 5, 58-60 and 64-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 50 and 57 is/are rejected.
- 7) ☒ Claim(s) 61-63 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/9/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>see office action</u> . | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of Group II, claims 50, 57 and 61-63, in the Reply filed on June 5, 2006, is acknowledged.

Claims 5, 50, and 57-69 are pending; claims 5, 58-60 and 64-69 are withdrawn as being directed to a non-elected invention; claims 50, 57 and 61-63 are the subject of the Office Action below.

### ***Information Disclosure Statement***

The information disclosure statements (IDS) submitted on February 18, 2005; May 4, 2005; and November 9, 2005, have been considered by the Examiner. The submissions are in compliance with the provisions of 37 CFR § 1.97. Enclosed with this Office Action is a return-copy of the Form PTO-1449 with the Examiner's initials and signature indicating those references that have been considered.

### ***Claim Objections***

Claims 61-63 are objected to for depending from a canceled base claim. Correction or cancellation of claims 61-63 is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 50 and 57 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 50 is indefinite for reciting the term "information" because one of ordinary skill in the art would not reasonably be able to determine what data, numbers, or descriptors meet the limitation of "information" in Applicants' claimed invention. Neither the specification nor the

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context of the claim reasonably provide enough support to determine the metes and bounds of this limitation. Correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 50 and 57 are rejected under 35 U.S.C. 102(b) as being anticipated by Dauter *et al.*, *Acta Crystallographica D*57:239-249 (2001).

Claim 50 is directed to a method for designing a lead candidate compound towards a biological target molecule comprising, combining the target with a mixture comprising two compounds, wherein at least one of the compounds comprises a substituent having anomalous dispersion properties, followed by a structural determination, followed by the selection of “information” for the design of the lead candidate. Claim 57 further requires the use of the dispersion properties of the substituent.

Dauter teaches a method for determining the crystal structure of pepstatin-insensitive carboxyl proteinase (PCP), by soaking a PCP crystal in the presence of sodium bromide and lithium sulfate (see page 241, column 1). The sodium bromide has anomalous dispersion properties, which are used in the measurement. The structure of this target complex is solved (see page 248, column 1). Also see the experimental and discussion of crystal forms I and II.

### ***Conclusions***

No claim is allowable.

If Applicants should amend the claims, a complete and responsive reply will clearly identify where support can be found in the disclosure for each amendment. Applicants should point to the page and line numbers of the application corresponding to each amendment, and provide any statements that might help to identify support for the claimed invention (*e.g.*, if the

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amendment is not supported *in ipsis verbis*, clarification on the record may be helpful). Should Applicants present new claims, Applicants should clearly identify where support can be found in the disclosure.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeff Lundgren whose telephone number is 571-272-5541. The Examiner can normally be reached from 7:00 AM to 5:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Peter Paras, can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JSL

My-Chau Tran  
Patent Examiner

